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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,682	10/05/2001	Jerome Fournier	Q66648	1857

7590 01/13/2006
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, NW
Washington, DC 20037-3213

EXAMINER

GRAY, JILL M

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/970,682	Applicant(s) FOURNIER ET AL.	
	Examiner Jill M. Gray	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-6, 8-20, 24-27 and 29-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 5, 6, 9-11, 13, 14, 19, 24, 26, 27 and 33 is/are rejected.
- 7) ☒ Claim(s) 4, 8, 12, 16-18, 20, 25, 29-32, 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The rejection of claims 9-10 and 13 under 35 U.S.C. 112, first paragraph is moot in view of applicant's amendments.

The rejection of claim 11 under 35 U.S.C 112, second paragraph is moot in view of applicants' amendment.

The rejection of claims 3-7, 9-10, 12-14, 16, 19-20, 24-28, 30, and 33-34 under 35 U.S.C. 102(b) as being anticipated by or in the alternative under 35 U.S.C 103(a) as obvious over Tonyali 5,401,787 is moot in view of applicants' amendments.

The rejection of claims 2, 5-6, 9-11, 13-14, 19, 23, 26-27, and 33 under 35 U.S.C. 102(b) as being anticipated by Berger 4,499,149 is moot in view of applicants' amendments.

The rejection of claims 3-7, 10, 12-16, 19-20, 24-28, 30, and 33-34 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Borke et al, 6,197,864 B1 is moot in view of applicants' amendments.

The rejection of claims 8, 17, 18, 29, and 31-32 under 35 U.S.C. 103(a) as being unpatentable over Tonyali 5,401,787 in view of Bambara et al, US 2003/0087976 A1 is moot in view of applicants' amendments.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3, 5-6, 9-11, 13-14, 19, 24, 26-27, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger 4,499,149 as applied in the previous Office Action.

Berger is as set forth previously and teaches siloxane containing polymers comprising mineral fillers and method of making, per claims 3, 9-10, 13-14, and 24. The polymers can be polyimide, polyamideimide, polyester or polyurethane as required by claims 2 and 23. See abstract, column 2, lines 43-45, and column 54, lines 47-48. The polyimides are suitable as wire enamel and contain mineral fillers of the type contemplated by applicants in claims 5-6, 19, 26-27, and 33 (see column 36, lines 5-10). In addition, Example XXXV of Berger teaches the synthesis of the polyimide coating performed using N-methylpyrrolidone solvent as required by claim 11, and Example XXXVII teaches applying this coating on a wire and setting the coating and that said coatings are useful in the manufacturing of windings, as required by claims 13 and 14. Berger additionally teaches solutions of polyamideimides containing siloxanes can be applied to electrical conductors such as wires because of their high temperature resistance and corona resistance, as contemplated by applicants in claims 13 and 14. See column 39, lines 48-57. The siloxanes of Berger are formed from alkoxysilanes, see column 67, lines 52-59. It should be noted that applicants' claim language in claim 9 of "a copolymer obtained from a thermoplastic or thermosetting resin and at least one alkoxysilane" does not exclude copolymers wherein the alkoxysilane is a precursor or intermediate.

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Berger is silent as to the property of the winding wire being able to withstand peak-to-peak voltages of up to 3 kV at a frequency of up to 20 kHz with rise times of up to 1 kV/ μ s at a temperature of up to 108°C in claims 1 and 14 and the amount of filler material. In this regard, the composition of Berger is the same as or substantially similar to that contemplated by applicants. Accordingly, the examiner has reason to believe that the properties such as peak-to-peak voltages are the same as well, in the absence of clear factual evidence to the contrary. In the alternative, it would have been obvious to adjust the properties of the insulation by adjusting the amount of mineral filler present in the composition. Also, since a composition of the type contemplated by applicants is known, it is the examiner's position that since the results sought and the ingredients used were known, it was within the expected skills of one having ordinary skill in the art to arrive at the optimum proportion of those ingredients. Therefore, it would have required no more than routine experimentation to determine the optimum value for filler material in the composition of Berger.

Therefore, the teachings of Berger would have rendered obvious the invention as claimed in present claims 5-6, 9-11, 13-14, 19, 26-27, and 33.

Claim Objections

3. Claims 20 and 34 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. These claims are depended upon cancelled claims.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More specifically, claim 26 does not further limit amended claim 14. Hence, the metes and bounds for which patent protection is being sought are not clear.

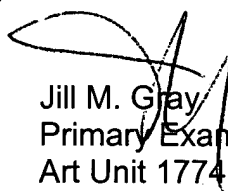
6. Claims 4, 8, 12, 16-18, 25, and 29-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jill M. Gray
Primary Examiner
Art Unit 1774

jmg